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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	94002525
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Pending Application Serial No. 77/779,339

Application Filing Date: July 13, 2009

Publication Date: June 22, 2010

Boi Na Braza, LLC,

Applicant,

vs.

Terra Sul Corporation a/k/a  
Churrascaria Boi Na Brasa,

Excepted User.

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Concurrent Use No. 94002525

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**EXCEPTED USER TERRA SUL CORPORATION'S TRIAL BRIEF**

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Excepted User Terra Sul Corporation ("Terra Sul" or "Excepted User") submits this trial brief pursuant to 37 C.F.R. § 2.128(a)(1) and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 801.02(b).

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## **DESCRIPTION OF THE RECORD**

For consistency, where evidence of record as an exhibit to Excepted User Terra Sul's Notice of Reliance ("NOR") is relied upon in the present Trial Brief, reference will be made to "NOR Exhibit X". Evidence of record also comprises two exhibits to Terra Sul's Motion to Use Testimony from a Prior Proceeding dated October 18, 2012. These exhibits, where applicable, will be referred to as "Motion Exhibit A" and "Motion Exhibit B". The evidence of record consists of the following documents:

1. Pleadings and discovery from the present proceeding

1.1 Excepted User Terra Sul's Exhibits:

NOR Exhibit A. Boi Na Braza's Objections and Answers to Excepted User Terra Sul's First Set of Interrogatories (Nos. 1-50).

NOR Exhibit B. Boi Na Braza's Objections and Responses to Excepted User Terra Sul's First Set of Requests for Admissions (Nos. 1-23).

Motion Exhibit A. Selected portions of a discovery deposition of Mr. Farid Saleh of Terra Sul dated March 25, 2008 (relevant pages 30-86 and 91-92) and exhibits from the deposition (Exhibits 11-13). This discovery deposition was from a prior cancellation proceeding involving the same parties and is properly introduced by Motion dated October 10, 2012. The entire deposition and exhibits is also part of the official record of the prior Cancellation Proceeding No. 92047056 and appears as NOR Exhibit D.

Motion Exhibit B. Selected portions of a testimony deposition of Mr. Saleh dated August 7, 2008 (relevant pages 40-49, 58-72 and 88-95) along with exhibits thereto (Exhibits 15-17 and 22). This testimony deposition was from a prior cancellation proceeding involving the same parties and is properly introduced by Motion dated October 10,

2012. The testimony deposition and exhibits are also attached as Exhibit A to NOR Exhibit E (Terra Sul's Trial Brief on the Merits in Cancellation Proceeding No. 92047056).

1.2 Documents relied upon by Applicant:

Terra Sul Corporation's Objections and Responses to Applicant's First Set of Requests for Admission (Nos. 1-10).

Terra Sul Corporation's Objections and Responses to Applicant's First Set of Interrogatories (Nos. 1-38).

2. Official Records

2.1 The entire record from Cancellation Proceeding No. 92047056. Excerpted portions appear as:

- |                |   |
|----------------|---|
| NOR Exhibit C. | A docket sheet for the entire record of prior Cancellation Proceeding No. 92047056 involving the same parties hereto.   |
| NOR Exhibit D. | Docket entry 24 from Cancellation Proceeding No. 92047056: Applicant's notice of reliance and a discovery deposition of Mr. Farid Saleh and exhibits which were introduced by way of notice of reliance by the Applicant Boi Na Braza in the prior cancellation proceeding. Excerpted portions of the discovery deposition and exhibits are also found at Motion Exhibit A. |
| NOR Exhibit E. | Docket entries 28 and 30 from Cancellation Proceeding No. 92047056: Terra Sul's Trial Brief on the Merits dated February 27, 2009.  |
| NOR Exhibit F. | Docket entry 35 from Cancellation Proceeding No. 92047056: Terra Sul's Rebuttal Brief dated April 30, 2009.   |

NOR Exhibit G.        Docket entry 37 from Cancellation Proceeding No. 92047056: the Board's decision cancelling the registration of Boi Na Braza.

2.2        The entire application file for U.S. Trademark Application No. 77/813,416, which appears as:

NOR Exhibit H.        A copy of application status and documents from U.S. Trademark Application No. 77/813,416 for the mark CHURRASCARIA BOI NA BRASA obtained from the Trademark Status and Document Retrieval database of the U.S. Patent and Trademark Office.

2.3        The entire application file for U.S. Trademark Application No. 77/813,335, which appears as:

NOR Exhibit I.        A copy of application status and documents from US. Trademark Application No. 77/813,335 for the mark BOI NA BRASA obtained from the Trademark Status and Document Retrieval database of the U.S. Patent and Trademark Office.

2.4        The entire application file for U.S. Trademark Application No. 76/088,982, which appears as:

NOR Exhibit J.        A copy of application status and documents from U.S. Trademark Application No. 76/088,982 for the mark BOI NA BRAZA & Design (U.S. Trademark Registration No. 2,666,968) obtained from the Trademark Status and Document Retrieval database of the U.S. Patent and Trademark Office.

2.5        The entire application file for U.S. Trademark Application No. 75/748,967, which appears as:

NOR Exhibit K. A copy of application status and documents from U.S. Trademark Application No. 75/748,967 for the mark BOI NA BRAZA (U.S. Trademark Registration No. 2,534,608) obtained from the Trademark Status and Document Retrieval database of the U.S. Patent and Trademark Office.

3. Printed Publications

3.1 Printed Publications submitted with Terra Sul's Notice of Reliance:

NOR Exhibit L. The Star Ledger – Friday September 6, 2002, selected pages.

NOR Exhibit M. Luso-Americano – January 3, 2003, p. 15-16 and 35-38; April 27, 2007 p. 18.

NOR Exhibit N. Brazilian Times – July 2, 2010, p. 1, 4 and 6.

NOR Exhibit O. Brazilian Voice – May 22-25, 2010, p. 14; May 29, 2010 – June 1, 2010, p. 1 and p. 3.

NOR Exhibit P. Brazilian Press – May 17, 2008, p. 1, 3 and 17; June 13, 2007, p. 1, 8-10 and 47-50; January 2007, p. 1-24; August 24, 2005, p. 1-56; May 28, 2005, p. 1-24; September 8, 2003, p. 1-16; February 22, 2003, p. 1 and 54; January 6, 2003, pages 7-10; December 28, 2002, pages 1-2 and 13; December 14, 2002, pages 1-2; September 26, 2001, p. 16; December 6, 2000, page 62; November 17, 1999, p. 1 and 23; September 17, 1997, p. 1 and 12.

NOR Exhibit Q. Brazilian Press – October 18, 2012 p. 1, 4 and 10; September 27, 2012 p. 1, 4, 10, 26-29 and 38-39.



## **STATEMENT OF THE ISSUES**

Excepted User Terra Sul Corporation ("Terra Sul") opposes the concurrent use application serial no. 77/779,339 for the word mark BOI NA BRAZA by Applicant. If the application is granted with the geographic scope sought (either the entire country excluding the State of New Jersey, or the entire country excluding the States of New York and New Jersey), the use of the mark BOI NA BRAZA is likely to cause confusion, mistake or deception with regard to Terra Sul's prior rights in the service mark CHURRASCARIA BOI NA BRASA as the senior user. Thus, the issue to be decided by the Board is whether Applicant, a junior user having only two restaurants, one in Texas and one in Ohio, using the mark BOI NA BRAZA, is entitled to registration of the mark with a geographic scope of nearly the entire country in contravention to the preexisting rights of the senior user Terra Sul.

## **RECITATION OF THE FACTS**

### **A. Formation of Churrascaria Boi Na Brasa**

Farid Saleh, the owner of Terra Sul, first conceived of a restaurant called "Churrascaria Boi Na Brasa" in 1995, and commissioned the design of a logo through a friend. Exhibit A to NOR Exhibit E, at pages 38-40; see also, Exhibit A-17 to NOR Exhibit E. The service mark CHURRASCARIA BOI NA BRASA was first used to identify its restaurant services at least as early as 1996 in Newark, New Jersey. Exhibit A to NOR Exhibit E, at page 39. In 1996, the original name of the corporate entity that owned the mark was "Churrascaria Boi Na Brasa Corp." See Exhibit A-1 to NOR Exhibit E; see also Exhibit A to NOR Exhibit E, at page 6, lines 17-22. Churrascaria Boi Na Brasa Corp. was incorporated in the State of New Jersey on March

28, 1996 and began doing business at 70 Adams Street in Newark shortly thereafter. See Exhibits A-1 and A-2 to NOR Exhibit E; see also Exhibit A to NOR Exhibit E at pages 5-8.

Terra Sul Corporation was formally incorporated in the State of New Jersey on January 18, 1999. Exhibit A-18 to NOR Exhibit E; Exhibit 18 to Motion Exhibit B. Soon after its formation, Terra Sul acquired ownership of the restaurant "Churrascaria Boi Na Brasa" and the associated service mark CHURRASCARIA BOI NA BRASA. Exhibit A to NOR Exhibit E, at page 51, lines 16-25. The restaurant always was and still continues to be known as "Churrascaria Boi Na Brasa", and in 2007, Terra Sul formally filed for a Registration of Alternate Name in New Jersey. See Exhibit A-19 to NOR Exhibit E.

In addition, the mark BOI NA BRASA is used by Gullas Corp., which owns and operates Boi Na Brasa Bar and Grill, also in Newark, NJ. Farid Saleh is also the president of Gullas Corp. Motion Exhibit B p. 66; Exhibit A to NOR Exhibit E p. 66.

B. Market scope of Terra Sul's past and present operations

When Churrascaria Boi Na Brasa opened in 1996, no one else used the name "Boi Na Brasa" in the restaurant business. See Exhibit A to NOR Exhibit E, at page 39-40. Churrascaria Boi Na Brasa was first advertised through flyers and word of mouth and later through newspapers. *Id.* By September 1997, Churrascaria Boi Na Brasa was regularly advertised in the Brazilian Press. See Exhibit A-15 to NOR Exhibit E. Terra Sul continues to market its restaurants Churrascaria Boi Na Brasa and Boi Na Brasa Bar and Grill through the Brazilian Press. See NOR Exhibits P and Q (advertisements in Brazilian Press from 1997 through 2008, and as recently as September-October 2012). Notably, Brazilian Press has a strong regional and semi-national reach. For example, two recent issues indicate "NJ-NY-CT-MA-PA-W/DC-MD"

below the banner. These issues also includes advertisements for businesses in New Jersey, New York and Pennsylvania on the respective first pages, and indicate columnists for PA, NY/NJ, CT and NJ in the credits on the respective fourth pages. See NOR Exhibit Q.

Terra Sul also regularly marketed, and continues to market its two restaurants Churrascaria Boi Na Brasa and Boi Na Brasa Bar and Grill through other publications including Brazilian Times, Brazilian Voice and Luso Americano. See Motion Exhibit A-11 (Bates No. TS 000681, advertising invoice from Brazilian Voice dated February 2, 2000); NOR Exhibit M (advertisements in Luso Americano January 3, 2003); NOR Exhibit N (advertisements in Brazilian Times July 2, 2010); NOR Exhibit O (advertisements in Brazilian Voice from at least as recently as May-June 2010). Notably, Luso Americano is directed to at least the New York, New Jersey and Pennsylvania areas. For example, in the same paper that bears advertisements for Boi Na Brasa (Churrascaria Boi Na Brasa), pages are dedicated to articles, advertisements and/or event announcements for Mount Vernon, NY, Yonkers, NY as well as Philadelphia, PA. See NOR Exhibit M.

Similarly, Brazilian Times is directed to at least the areas of New York, New Jersey, Connecticut, Pennsylvania, Massachusetts and Florida. See NOR Exhibit N. As just one example, the issue dated July 8, 2010 states on the first page above the banner “New York \* New Jersey \* Connecticut \* Pennsylvania”. In addition, the second page of the same issue indicates regional offices located in New York, NY, Newark, NJ, Bridgeport, CT, Somerville, MA and Miami, FL.

Likewise, Brazilian Press also has a semi-national reach. For example, the June 13, 2007 issue, below the banner, states “New Jersey \* New York \* Connecticut \* Massachusetts \* Florida \* Washington, DC \* Virginia \* Maryland \* California \* Rhode Island \* Pennsylvania \*

Georgia". See NOR Exhibit P (June 13, 2007 issue of Brazilian Press, beginning at Bates No. TS 001115). In the same issue the lead article relates to New Haven, CT and includes an advertisement for a business in the 215 area code (Pennsylvania). See *id.*

At least as early as July 1999 Terra Sul marketed itself through various promotional items such as t-shirts, sweat shirts, magnets, ski hats and carabiner clips. See Motion Exhibit A-11 (documents bearing Bates numbers TS 000311-000312, TS 000623, TS 000440, TS 000769). Within a short amount of time, the restaurant Churrascaria Boi Na Brasa and the associated service mark CHURRASCARIA BOI NA BRASA had become well-known to the relevant public, primarily in the Tri-state area of New York, New Jersey and Connecticut. From 1996 to the present day, the restaurant on 70 Adams Street in Newark, New Jersey has been continuously known as "Churrascaria Boi Na Brasa" and the name has never changed. See Exhibit A to NOR Exhibit E, at page 51, lines 8-15, and pages 97-98.

In addition, in at least 2003 and 2004 and 2007, Terra Sul marketed Churrascaria Boi Na Brasa through television advertising on TV Globo International (Dish Network channel 596). It also had advertisements that ran on the Food Network and ESPN (on Comcast Cable) as well as on CNN and Fox. See Motion Exhibit A p. 70-74; Motion Exhibit A-11 (documents bearing Bates Nos. TS 001032, TS 000771 and TS 000890). Notably, the advertisements on TV Globo International were nationally televised and distributed advertisements. See Motion Exhibit A p. 71. The Comcast Cable advertisements were not nationally distributed but at least reached New Jersey, New York City and Staten Island.

In at least 2005 and 2006, Churrascaria Boi Na Brasa provided food services at street fair/festival events in New York City. See Motion Exhibit A p. 81. The restaurant has also occasionally provided catering services in the State of New York. See Exhibit A to NOR Exhibit

E, p. 48; Motion Exhibit B, p. 48. The Village Voice also named it the "Best Choice Churrascaria" restaurant for 2006. See Exhibit A-22 to NOR Exhibit E. Village Voice is a well-known New York City based newspaper (see, e.g., [www.villagevoice.com](http://www.villagevoice.com)). Farid Saleh also registered a domain name for the restaurant, and maintains an Internet website presence at [www.boinabrasa.com](http://www.boinabrasa.com). Exhibit A to NOR Exhibit E, at page 58, lines 1-17; Motion Exhibit B at p. 58 lines 1-17. The service mark CHURRASCARIA BOI NA BRASA has been continuously used to identify the restaurant at 70 Adams Street in Newark, New Jersey. Exhibit A to NOR Exhibit E, at pages 97-99. There has never been an abandonment of the use of this service mark that identifies this restaurant. *Id.*

C. Applicant Boi Na Braza's status as junior user

According to the Applicant it was only "in the second half of 1998, the Matheus Brothers researched and chose this name for their restaurant business and purchased land to build their first restaurant." See Exhibit D to NOR Exhibit E, Interrogatory No. 26. By its own admission, the earliest that Applicant's mark was in existence was maybe the "second half of 1998." *Id.* Moreover, the corporate entity, Boi Na Braza, Inc., was not registered in the State of Texas until June 24, 1999. See Exhibit E to NOR Exhibit E. It should be noted that the corporate name has recently been changed to Boi Na Braza, LLC as set forth in Applicant's motion for an entry of name change submitted in the present proceeding on August 21, 2102 (docket entry 16 in the present proceeding). Lastly, Applicant Boi Na Braza's webpage [www.boinabrasa.com](http://www.boinabrasa.com) was not online and accessible until June 26, 2000 at the earliest. See Exhibit C to NOR Exhibit E, Request No. 18. By this time, Churrascaria Boi Na Braza had already acquired significant goodwill and established a reputation through its presence in the restaurant industry.

Applicant's first "Boi Na Braza" restaurant was opened in Grapevine, TX in 1999. Applicant later opened similar restaurants under the same name in Cincinnati, OH and Atlanta, GA. See Exhibit D to NOR Exhibit E, Interrogatory No. 32. The Atlanta restaurant later became owned and controlled by a licensee of the mark. *Id.*; see also Exhibit B to NOR Exhibit E, Interrogatory No. 23. However, it appears that in 2007 the name of the restaurant at the relevant address 3207 Peachtree Road, Atlanta, GA, was changed to "Chima". In addition, by 2009 the restaurant appears to have been closed completely. See, e.g., <http://www.bizjournals.com/atlanta/stories/2009/03/02/daily61.html>, article from Atlanta Business Chronicle dated March 4, 2009, visited 7-12-13. Thus, between 2007 and present, Applicant's operations have if anything, contracted.

Accordingly, at present Applicant appears to operate only two restaurants that use the name "Boi Na Braza", the one in Grapevine, TX, which is a suburb in the Dallas-Fort Worth area, and the other in Cincinnati.

D. The previous cancellation proceeding involving the same parties

Applicant Boi Na Braza, Inc. filed for a federal trademark registration for the word mark BOI NA BRAZA on July 1, 1999. Applicant obtained the registration (No. 2,534,608) on January 29, 2002. At this time, Applicant was wholly unaware of the Excepted User or the existence of Excepted User's mark CHURRASCARIA BOI NA BRASA. See Exhibit A to NOR Exhibit E at page 58, lines 22-25. On January 11, 2007, Applicant sent Farid Saleh a letter demanding that all use of its names "Churrascaria Boi Na Brasa" and/or "Boi Na Brasa Bar & Grill" be ceased in connection with Excepted User's restaurant business. *Id.*; see also Exhibit A-21 to NOR Exhibit E. Shortly thereafter, on January 29, 2007, Terra Sul initiated a Cancellation

Proceeding against Boi Na Braza seeking to cancel the geographically unrestricted Registration No. 2534608 for the mark BOI NA BRAZA for “restaurant services” in class 042. NOR Exhibit C. On June 12, 2009, the Board granted Terra Sul’s petition in Cancellation Proceeding No. 92047056. NOR Exhibit G, Board decision in Cancellation Proceeding No. 92047056, p. 3-4.

In particular, the Board determined that there clearly exists a likelihood of confusion between the marks BOI NA BRASA and BOI NA BRAZA under Section 2(d) of the Trademark Act. See NOR Exhibit G, p. 3-4. The Board further determined that as the first user of the BOI NA BRASA mark in commerce, Terra Sul is the senior user with common law rights that supersede Applicant Boi Na Braza's alleged rights to the similar mark BOI NA BRAZA. See NOR Exhibit G, p. 12. Having thus established that Terra Sul is the senior user and that a likelihood of confusion exists between the marks under Section 2(d) of the Trademark Act, the Board ordered the registration for the word mark BOI NA BRAZA be cancelled. *Id.*

E. The present dispute

Having thus had its geographically unrestricted registration cancelled for the mark BOI NA BRAZA, on July 13, 2009, Applicant filed Application No. 77/779,339 to register the mark BOI NA BRAZA for “restaurant and bar services” in class 043 with a geographic restriction of the entire United States excluding New Jersey. On August 23, 2010, Terra Sul filed a Notice of Opposition against Application No. 77/779,339, which was assigned Opposition No. 91196845. On December 13, 2011, the Board dismissed Opposition No. 91196845 without prejudice and instituted the present Concurrent Use Proceeding No. 94002525. On June 6, 2012, Applicant filed a motion to amend the Application to exclude both the State of New Jersey and the State of

New York. Since Terra Sul has not consented to the motion, the motion has been deferred for decision along with the present trial.

## ARGUMENT

### A. Statement of Law

As noted in TBMP 1103.01(d)(2), a subsequent user who “in good faith, and without knowledge of a prior party’s use in another geographic area, adopts and uses the same or similar mark for the same or similar goods or services within its own geographic area,” may obtain certain rights concurrent to those of the prior party/senior user. However, “as a general rule [a] prior user is entitled to registration covering the entire United States except for geographic area in which [a] subsequent user has actually used the mark plus an area shown to be within the natural expansion of its business.” See TBMP 1103.01(d)(2) note 2, citing *Pinocchio’s Pizza, Inc. v. Sandra, Inc.*, 11 USPQ2d 1227, 1229 (TTAB 1989).

In the seminal case of *Beatrice Foods Co. v. Fairway Foods, Inc.*, 429 F.2d 466 (CCPA 1970), the court of appeals instructed that there are two conditions precedent to the issuance of concurrent registrations: (1) “the parties must be presently entitled to concurrently use the mark in commerce” and (2) there must be “no likelihood of confusion, mistake or deception in the market place as to the source of the goods resulting from the continued concurrent use of the trademark.” See *Beatrice Foods*, 429 F.2d at 1473-74. The court further instructed that:

in concurrent use proceedings in which neither party owns a registration for the mark, the starting point for any determination as to the extent to which the registrations are to be territorially restricted should be the conclusion that the prior user is prima facie entitled to a registration governing the entire United States. Such a prior user, who applies for a registration before registration is granted to another party, is entitled to a registration having nationwide effect no less than if there were no concurrent user having registrable rights. His rights and, therefore, his registration, should be limited only to the extent that any other subsequent



user, who can establish rights earlier than the prior user's application for registration, can also prove a likelihood of confusion, mistake or deception.

See *id.* at 1474 (emphasis added).

Thus, only limited circumstances have supported granting greater rights to a subsequent user in derogation of the senior user's rights. For example, in *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512 (CCPA 1980), the court granted a nearly-nationwide registration to a national franchise that was a subsequent user where, among other things, the franchise had vigorously expanded, with 137 locations in 34 states, had over thirty two million dollars in sales in a two-year period (in the mid-1970s), had already obtained several registrations surrounding the mark WIENER KING and had obtained *substantial* nationwide goodwill surrounding the mark through its own efforts. The senior user operated a similar restaurant business but was local to New Jersey, operating primarily out of a single location for many years and without much advertisement. In addition, it appears that the applicant was seeking to register new marks related to the previously registered WIENER KING mark. Notably, the large, expanding junior user was already in possession of a nationwide registration of the mark WIENER KING. Thus, the concurrent use proceeding was considered in conjunction with at least three cancellation proceedings relating to marks previously obtained by the junior user. In such circumstances, given the vigorous national expansion of the junior user, and given the great discrepancy in size, profits, advertising and national recognition, and in view of the fact that the applicant was already in possession of the mark WIENER KING, the applicant was granted a substantially nationwide registration with the exception of two portions of New Jersey.

In another example, in *Terrific Promotions, Inc. v. Vanlex, Inc.*, 36 USPQ2d 1349 (TTAB 1995), the Board found that a junior user that was a large nationally expanding retail chain was

entitled to registration of a mark that included the entire territory of the United States with the exception of New York City, Westchester County and several counties in northern New Jersey, Long Island and southern Connecticut, where the senior user was at a single location in New York City. However, the applicant had at least seven stores in Virginia, Illinois and Indiana. In addition, in determining the geographic scope to be afforded to the applicant, the Board seemed to be influenced by (1) its determination that there were substantial visual differences in the marks and (2) that the types of businesses of the applicant and the excepted user were somewhat different. *See id.*

In contrast, in *Georgia-Southern Oil, Inc. v. Richardson*, 16 USPQ2d 1723 (TTAB 1990), a senior user was using the mark HUNGRY HARVEY'S as early as 1982 at a fast food restaurant and convenience store attached to a gas station in southeastern Georgia. The junior user operated a chain of 28 gas station convenience stores, 19 of which used the mark HUNGRY HARVEY in the northwestern portion of Georgia. The junior user was found to have acted in good faith, since it was unaware of the senior user when it began using the mark in 1984. Nevertheless, the junior user was restricted to its area of actual use and a zone or "area of natural expansion" that included only Floyd, Polk, Haralson, Cobb and Cherokee counties, where the junior user was actually using the mark, and the contiguous and close-in counties immediately surrounding Rome, Georgia, i.e., the additional counties of Bartow, Paulding, Pickens, Gordon and Chattooga as an area of natural expansion. *See id.* at 1725.

In that case, the Board noted that the relevant issue was "whether applicant has demonstrated that it is entitled to registration of its service mark for the geographic area set forth in its application, that is, the entire United States except for McIntosh County, Georgia." 16 USPQ2d at 1724. The Board also reiterated that "the primary concern in determining whether

and to what extent a registration is to be granted to applicant is the avoidance of likelihood of confusion.” See *id.*, citing *Beatrice Foods*, 429 F.2d at 466, 166 USPQ 431 at 437. The Board further noted that “plaintiff in this concurrent use proceeding, has the burden of proof of demonstrating its entitlement to a concurrent use registration,” and that as a general rule, “a prior user of a mark is entitled to a registration covering the entire United States limited only to the extent that the subsequent user can establish that no likelihood of confusion exists and that it has concurrent rights in its actual area of use, plus its area of natural expansion.” See *id.*, citing *Ole Taco Inc. v. Tacos Ole, Inc.*, 221 USPQ 912, 915 (TTAB 1984), and citing *Pinocchio's Pizza v. Sandra*, 11 USPQ2d at 1228.

## **DISCUSSION**

### **A. The mark BOI NA BRAZA is confusingly similar to Excepted User’s mark BOI NA BRASA**

As mentioned above, the Board has already determined that the work mark Applicant seeks to register, BOI NA BRAZA, is confusingly similar to the mark BOI NA BRASA that was first used by senior user Terra Sul. As part of its determination, the Board noted that the marks both relate to the same business of “restaurant services” and that “the trade channels overlap.” See NOR Exhibit G, p. 3-4. Thus, as junior user, in order to obtain a concurrent use registration with a geographic restriction, Applicant needs to show that no likelihood of confusion will result. See, e.g., *Beatrice Foods*, 429 F.2d at 1473-74.

In this case, Applicant has requested registration for the entire United States with the exception of the State of New Jersey, and alternatively for registration for the entire United States with the exception of the states of New Jersey and New York. However, Applicant fails

to meet its burden to show that it is entitled to a registration for anywhere other than its current areas of actual use, or its areas of current and past actual use. See, e.g., *Beatrice Foods*, 429 F.2d at 1473-74; see also, *Georgia-Southern Oil v. Richardson*, 16 USPQ2d 1723.

B. Applicant is not entitled to New York

Terra Sul's restaurants are located in Newark, New Jersey. However, its natural market at the very least includes New York City and significant portions of New York State. In its Trial Brief, Applicant attempts to separate Newark from the New York City metro area to which it clearly belongs by characterizing the Churrascaria Boi Na Brasa restaurant as being separated from New York City by ten miles and three river crossings. (See Applicant's Trial Brief, p. 6). However, it is so well established that northern New Jersey, and Newark in particular, are part of the New York metro area that any assertions to the contrary are flatly incorrect. To the extent the Board requires specific proof of the matter, reference is made to Terra Sul's Answer in the present Concurrent Use proceeding dated January 19, 2012. (Docket entry no. 3, p. 3-4, paragraphs 3-8 and Exhibit B). For example, as noted in the Answer, The U.S. Census Bureau defines New York-Northeastern NJ as Standard Metropolitan Statistical Area (SMA) # 35620 (the New York-Northern New Jersey-Long Island SMA). See *id.* at p. 3 paragraph 4(a).

In any event, Terra Sul has invested in substantial, regular and sustained advertising and marketing efforts that target New York City and State. For example, as described above advertisements in Brazilian Press, Brazilian Times and Brazilian Voice between 1997 and the present have consistently targeted New York City and the State of New York among other regions. Terra Sul has also directed television advertisements to markets and audiences throughout the New York area. See Recitation of Facts, *supra*. In addition, notwithstanding Terra

Sul's own efforts, restaurants located in Newark are often considered as part of the New York City restaurant scene (for example, as indicated by accolades in the Village Voice). See Recitation of Facts, *supra*.

Accordingly, it is simply not possible to have a restaurant use the mark BOI NA BRAZA in New York City or in New York State without causing confusion with senior user Terra Sul's businesses Churrascaria Boi Na Brasa and Boi Na Brasa Bar and Grill. In addition, Terra Sul has invested substantially in creating goodwill surrounding the mark BOI NA BRASA in the New York area, such that any resulting confusion would potentially diminish from the goodwill surrounding the mark. It would also not be proper to allow Applicant to reap the benefits of the goodwill already established for the mark BOI NA BRASA in the New York area. Thus, Application is clearly not entitled to a registration that includes New York City or New York State. In any event, Applicant has voluntarily moved to amend the application to exclude both the State of New Jersey and the State of New York, as opposed to only the State of New Jersey.

C. Applicant is not entitled to significant other portions of the United States

Although Applicant seeks a registration that includes all portions of the country excluding New Jersey, or excluding New Jersey and New York State, Applicant is clearly not entitled to other portions of the country in which senior user Terra Sul has invested and directed substantial advertising and marketing efforts. This includes at least Pennsylvania, Connecticut, Massachusetts, Rhode Island, Maryland, Washington, DC, Florida, Virginia and California. Specifically, Terra Sul has advertised using the mark BO NA BRASA in the Brazilian Press, which has a strong regional and semi-national reach and which specifically covers or has covered New Jersey, New York, Connecticut, Massachusetts, Pennsylvania, Florida, Washington, DC,

Maryland, Virginia, California, Rhode Island and Georgia. See NOR Exhibits P-Q. In addition, Terra Sul regularly advertises in the Brazilian Times, which is directed to at least the areas of New York, New Jersey, Connecticut, Pennsylvania, Massachusetts and Florida. See NOR Exhibit N. Terra Sul has also used national television advertising to promote its restaurant Churrascaria Boi Na Brasa. See Motion Exhibit A p. 70-74; Exhibit A-11 (documents bearing Bates Nos. TS 001032, TS 000771 and TS 000890).

Thus, Terra Sul has demonstrated significant nationwide areas of marketing and advertising penetration. On the other hand, Applicant Boi Na Braza remains the junior user and thus bears the burden of overcoming the presumption that “a prior user, who applies for a registration before registration is granted to another party, is entitled to a registration having nationwide effect no less than if there were no concurrent user having registrable rights.” See *Beatrice Foods*, 429 F.2d at 1474; see also *Georgia-Southern Oil v. Richardson*, 16 USPQ2d 1723.<sup>1</sup> In this case, Applicant has only demonstrated actual use of the mark BOI NA BRAZA in the Dallas, Atlanta and Cincinnati areas. In addition, it has claimed that it advertises nationally in Delta Sky and American Way magazines and has spent over two million dollars on such advertising. See Applicant’s Trial Brief p. 3. However, it is noted that its national marketing efforts are not clearly more substantial than those of the senior user Terra Sul, except in dollar amounts. In addition, the two parties herein are practically the same size, each operating two restaurants.

These circumstances are clearly not analogous to that of the *Weiner King* or *Terrific Promotions v. Vanlex* cases described above, which both involved significant discrepancies between the size of the parties, the extent of their promotional efforts and the differences is the

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<sup>1</sup> Terra Sul’s Trademark Applications No. 77/813,416 and 77/813,335 for the respective marks CHURRASCARIA BOI NA BRAZA and BOI NA BRAZA are pending and are awaiting the resolution of the present proceeding.

geographic scope of the parties' reputations. To the contrary, Applicant seeks a registration for the entire nation with the exception of New Jersey, or alternatively, for the entire nation with the exception of New Jersey and New York State. However, Applicant operates only a single restaurant in Texas (the original restaurant) and a single restaurant in Ohio bearing the name BOI NA BRAZA. This is not the type of sustained, continuous and substantial nationwide expansion which has previously supported granting a nearly-nationwide registration of a mark to a junior user. Furthermore, the geographic scope sought by Applicant extends well into the advertising market of Terra Sul, the senior user (e.g., at least Connecticut, Massachusetts, Pennsylvania, Florida, Washington, DC, Maryland, Virginia, California and Rhode Island), while Applicant fails to demonstrate any instances of actual use in any of these locations. Thus, Applicant fails to overcome the general presumption that a "prior user [Terra Sul] is entitled to registration covering the entire United States except for geographic area in which [a] subsequent user [Boi Na Braza] has actually used the mark plus an area shown to be within the natural expansion of its business." See TBMP 1103.01(d)(2) note 2, citing *Pinocchio's Pizza v. Sandra*, 11 USPQ2d at 1229; see also *Beatrice Foods*, 429 F.2d at 1474, and *Georgia-Southern Oil v. Richardson*, 16 USPQ2d 1723.

D. Applicant, as junior user, is entitled only to its areas of good faith actual use around the areas of Dallas, Texas, Atlanta, Georgia and Cincinnati, Ohio

As noted above, the general rule with respect to concurrent use cases is that a "prior user [e.g., Terra Sul] is entitled to registration covering the entire United States except for geographic area in which [a] subsequent user [e.g., Boi Na Braza] has actually used the mark plus an area shown to be within the natural expansion of its business." See TBMP 1103.01(d)(2) note 2, citing *Pinocchio's Pizza v. Sandra*, 11 USPQ2d at 1229; see also *Beatrice Foods*, 429 F.2d at

1474, and *Georgia-Southern Oil v. Richardson*, 16 USPQ2d 1723. As also noted above, Applicant fails to demonstrate that it satisfies any special circumstances that would warrant granting it any special rights greater than that to which it is entitled under the general rule articulated in these authorities. As such, Boi Na Braza's registration is properly restricted to areas in which it has demonstrated an actual good faith use plus an area of natural expansion<sup>2</sup>.

In this case, Applicant appears to have demonstrated actual use of the mark in the Dallas, Atlanta and Cincinnati areas. It has expressed a desire to open a restaurant in New York City. However, it has not described any significant concrete steps which it has taken to make this any more than an aspiration. In addition, it does not appear to have alleged any further actual expansions or any specific plans to expand to any other city, state or other region of the country. Thus, at best, Applicant articulates a valid right to use the mark in the Dallas, Atlanta and Cincinnati areas.

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<sup>2</sup> Applicant does not seem to articulate an area of natural expansion emanating from its areas of actual use, other than to assert that it has a desire to expand nationwide and open a restaurant in New York. Excepted User declines to establish an area of natural expansion based on Applicant's actual use where it is Applicant's burden to establish the relevant zone or area of natural expansion. However, Excepted User does not deny that Applicant is entitled to *some* area of natural expansion near to its current locations in Grapevine and Cincinnati and previous location in Atlanta.



## **CONCLUSION**

Thus, for all of the above reasons, registration of the mark BOI NA BRAZA should be denied to the extent sought by Applicant. Applicant has demonstrated good faith use prior to notice of the existence of senior user/excepted user Terra Sul in only three localities, one of which ceased to operate at least as early as 2009. Thus, to the extent that the Board deems that Applicant has any rights to the use of the mark BOI NA BRAZA, the use is appropriately restricted to the Applicant's areas of actual use, i.e., the Dallas, Texas area, Atlanta, Georgia area and Cincinnati, Ohio area. Although Applicant professes a desire to expand nationwide, its history and present status, i.e., at one time having only at most three restaurants, and actually contracting to two restaurants, indicate that whatever its zone of natural expansion, it certainly does not extend to 48 or 49 states, with only New Jersey or New York and New Jersey excepted.

Date: July 15, 2013

Respectfully submitted,

/s/ Eamon J. Wall

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TERRA SUL CORPORATION a/k/a  
CHURRASCARIA BOI NA BRASA

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of “**EXCEPTED USER TERRA SUL CORPORATION’S TRIAL BRIEF**” was served on the parties listed below, via ☐ hand delivery, ☒ first class mail, ☐ facsimile, and/or ☒ electronic mail on this 15th day of July, 2013.

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